

REMARKS

This is a full and timely response to the non-final Official Action mailed **October 25, 2004**. Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, various claims have been amended. No claims are cancelled. New claims 39-45 have been added. Claims 17-26 have been withdrawn pursuant to a previous Restriction Requirement. Thus, claims 1-16 and 27-45 are currently pending for further consideration.

The sole issue raised in the outstanding Office Action was a rejection of the examined claims based on cited prior art. Specifically, claims 1-6, 8-13, 15-16, 27-29, 31, 33-35 and 37 were rejected as anticipated under 35 U.S.C. § 102(b) by U.S. Patent No. 5,629,980 to Stefik et al. (“Stefik”). The other claims, 7, 14, 30, 32, 36 and 38 were rejected as being unpatentable under 35 U.S.C. § 103(a) taken alone. For at least the following reasons, these rejections are respectfully traversed.

Claim 1 recites:

An apparatus for distributing content over a network, comprising:
a distribution means interfaced to said network for distributing content onto said network, and at least one playback means interfaced to said network for receiving said distributed content,

wherein said distribution means:

 determines the existence of permission to make copies of said content;
 registers said at least one playback means to trace said content distributed to said at least one playback means;
 authenticates said at least one playback means;
 determines if said at least one playback means has permission to access said content;

requests an initiation of secure communications; and
transfers said content from said distribution means to said at least one playback
means; and
wherein said at least one playback means:
authenticates said distribution means;
instructs said distribution means to begin transferring said content; and
stores said distributed content transferred from said distribution means.

Applicant wishes to point out that the claimed apparatus provides for the transfer of content from a “distribution means” to a “playback means.” As described in Applicant’s specification, the “distribution means” and “playback means” may be part of user’s home entertainment system or the like. Specifically, the distribution means may be a set-top terminal that communicates with various playback means, such as “a personal computer, an optical disk player such as a compact disc (CD) player and a digital video disc (DVD) player, a portable player such as a personal digital audio player and an MP3 player, a video player, a hand-held computer, a cell phone or other personal communication devices, and any other device capable of receiving a digital bit stream.” (Applicant’s spec., para 0033).

In contrast, the system taught by Stefik deals with the transfer of protected content from a large “repository” to another repository or to a subscriber. Stefik does *not* discuss the transfer of protected content *within a subscriber’s system* from a “distribution means” to a “playback means.” According to Stefik,

Digital works are recreated on rendering systems. A rendering system is comprised of at least a rendering repository and a rendering device (e.g. a printer, display or audio system.) *Rendering systems are internally secure.* Access to digital works not contained within the rendering repository is accomplished via repository transactions with an external repository containing the desired digital work.
(Stefik, col. 4, lines 29-36) (emphasis added).

Thus, Stefik considers the subscriber's system (the "rendering system") to be "internally secure." Consequently, Stefik does not consider or address the ideas claimed by Applicant for securing the transfer of content within a rendering system, i.e., from a distribution means and to a "playback means" that plays back or produces the content.

Therefore, Stefik does not teach or suggest the claimed "distribution means" that "registers said at least one playback means to trace said content distributed to said at least one playback means;" "authenticates said at least one playback means;" "requests an initiation of secure communications [with the playback means];" and "transfers said content from said distribution means to said at least one playback means."

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claims 1-4 should be reconsidered and withdrawn.

Similarly, claim 5 recites:

A method for distributing multimedia content over a network, the method comprising:
requesting a transfer of said content;
determining the existence of permission to make copies of said content;
providing playback means identification from a playback means to a distribution means;
requesting said distribution means to authenticate said playback means;
requesting distribution means identification from said distribution means, said distribution means identification being requested by said playback means;
registering said playback means to trace said content distributed to said playback means, said step of registering being performed by said distribution means;

authenticating said playback means;
determining if said playback means has permission to access said content;
providing said distribution means identification to said playback means;
requesting an initiation of secure communications;
authenticating said distribution means;
instructing said distribution means to begin transferring said content; and
transferring said content from said distribution means to said playback means.
(emphasis added).

As demonstrated above, Stefik does not teach or suggest anything about the secured transfer of content within a rendering system, e.g., between a “distribution means” and a “playback means.” Consequently, Stefik fails to teach or suggest any of the emphasized elements of the method of claim 5.

“A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. For at least this reason, the rejection of claims 5-16 should be reconsidered and withdrawn.

Similarly, claim 27 recites:

A system for distributing content over a network, comprising:
a distribution device interfaced to said network for distributing content and
at least one playback device for playing or producing said content for a human user,
said at least one playback device being interfaced to said network for receiving said content,
wherein said distribution device determines existence of permission to make copies of said content and then encrypts said content for transmission to said at least one playback device to prevent unauthorized use or copying of said content.

Independent claim 33 recites:

A method for distributing content over a network, comprising:
determining existence of permission to make copies of content available from a distribution device that is in communication with at least one playback device; and,
if said permission exists, encrypting said content for secure transmission to said at least one playback device so as to prevent authorized use or copying of said content.

As above, Stefik fails to teach or suggest a system or method regarding the secured transfer of content between a distribution device and a playback device. Consequently, Stefik is inapposite to the subject matter recited in claims 27 and 33, and does not teach or suggest the various features of claims 27 and 33. For at least this reason, the rejection of claims 27-38 should be reconsidered and withdrawn.

Additionally, Applicant notes that the rejection of the claims base on Stefik is incomplete and cannot support a rejection of any claim. The present Office Action fails to cite any portion of Stefik or give any indication of how the Office reads the Stefik reference as anticipating or rendering obvious the claims in the present application.

It is incumbent upon the Examiner to identify where in the reference each element may be found. *Ex parte Levy*, 17 U.S.P.Q.2d 1461 (BPAI 1990). Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of unpatentability.

Newly added claims 39-45 are thought to be patentable for at least the same reasons given above with respect to the other independent claims. Consequently, examination and allowance of new claims 39-45 is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

DATE: 25 January 2005

Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)